

Notice of Allowability

Application No.

10/813,218

Examiner

Marc S. Zimmer

Applicant(s)

VEDULA ET AL.

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/11/07.
2. ☒ The allowed claim(s) is/are 1,3-6,10,13-15,17-27,29-33,35,37 and 40-45.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Allowable Subject Matter

Based on an indication of allowable subject matter in original claim 16, Applicant has amended claim 1 to include the limitations of that claim.

The Examiner had earlier observed that the corresponding polymer derived from a polyether glycol, diisocyanate, and hydroxyl-functional chain extender had been characterized in [0048] in terms of a dynamic viscosity, as opposed to in terms of a weight-average molecular weight as it is in the claims. Further, the Examiner could not conceive of what argument could be properly employed to demonstrate that the molecular weight limitation is *necessarily* satisfied. An attempt was made to find a resource that would correlate molecular weight and dynamic viscosity for similar polymer materials, but to no avail.

The Examiner had also considered whether or not it might have been appropriate to formulate a rejection holding the limitation as obvious but quickly concluded that this would not be a suitable rationale. Indeed, the reference outlines an explicit viscosity range. Accordingly, why would it be obvious to depart from that range, particularly not knowing how much of an adjustment would be necessary to even reach a viscosity that coincided with the lower limits of the claimed molecular weight range. (The Examiner assumes that, if the molecular weight range is not inherently satisfied, it is because the molecular weight of the corresponding prior art polymer is too low.)

In the last correspondence, the Examiner briefly mentioned JP 1-167389 as a possible foundation of rejection. A full translation of this document has been received and fully reviewed. This reference does, in fact teach a crosslinked reaction product

derived from a hydroxyl group-terminated polyester-urethane and an isocyanate group-terminated polyether-urethane. There is no express mention of making the polyester-urethane from a polyester polyol that, itself, was prepared from a mixture of branched- and linear polyols though the Examiner believes that this limitation could have been proven to be obvious for reasons that were stated previously.

Concerning the polyether-urethane component, as in the other reference, this component is characterized in terms of its viscosity. However, the viscosity recited is that for a single permutation of the genus of crosslinking agents labeled (a) by the reference. The viscosity reported on page 11 is 90,000 cp which seems to have a higher probability of being the viscosity associated with a polyurethane having the desired molecular weight as disclosed in claim 1 but, as before, the Examiner cannot confirm that the polyether-urethane product necessarily inherently satisfies the claimed molecular weight limitation.

As to the notion that the claimed molecular weight range might have been reached by an optimization of this parameter in the polyether urethane, it is noted that the reference advocates using the product described therein as an adhesive whereas the present composition is used to make fibers. It is not at all clear that an optimization of the viscosity/molecular weight in practicing the invention of the prior art would have led the skilled artisan to use polymers having the claimed molecular weight limitation insofar as different applications of the two inventions are cited, there being no explicit overlap in their utility.

For the record, it is acknowledged that the aforementioned polyether-urethane disclosed by way of example is synthesized in the absence of a chain extender. The Examiner believes, nevertheless, that had this been the only difference, a rejection under 35 U.S.C. 103 would have been merited.

The two documents cited herein represent the most germane prior art identified by the Examiner. Inasmuch as they fail to even render obvious the claimed invention, claims 1, 3-6, 10, 13-15, 17-27, 29-33, 35, 37, and 40-45 are allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 15, 2007

A handwritten signature in black ink, appearing to read "Marc S. Zimmer". The signature is fluid and cursive, with the first name "Marc" and last name "Zimmer" clearly distinguishable.

MARC S. ZIMMER
PRIMARY EXAMINER